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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

FJ-2001-041-US

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Application Number

10/058,924

Filed

January 30, 2002

First Named Inventor

Hisayoshi Tsubaki

Art Unit

2625

Examiner

Perungavoor, S. V.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 46,672

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

John J. Dresch

Typed or printed name

703-761-4100

Telephone number

May 1, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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Docket No. FJ-2001-041-US
(MAS.012)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Hisayoshi Tsubaki

Serial No.: 10/058,924

Group Art Unit: 2625

Filed: January 30, 2002

Examiner: Perungavoor, Sathyanaraya V.

For: IMAGE RECORDING METHOD AND SYSTEM, IMAGE TRANSMITTING
METHOD, AND IMAGE RECORDING APPARATUS

Honorable Commissioner of Patents
Alexandria, VA 22313-1450
Box AF

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Prior to developing a formal Appeal Brief, Appellants submit the following argument for review by more experienced Examiners under the pilot Pre-Appeal Brief Conference. Appellants concurrently file herewith a Petition for Extension of Time, for a one-month extension of time, and a Notice of Appeal.

Appellants hereby request that the Conference attendees refer to the full argument of Appellants on pages 17-30 of the Response filed Under 37 C.F.R. § 1.116, filed on February 16, 2006, and do not herein repeat these arguments in their entirety.

In addition to these arguments, Appellants respectfully submit that the Examiner clearly has not provided any evidentiary basis for the motivation in the rejection of claims 8, 18, and 22 under 35 U.S.C. § 103(a) as being unpatentable over McDonald, Wang, Kuperstein, and TIFF. Thus, Appellant submits that a *prima facie* case of obviousness clearly has not been properly established at least with respect to claims 8, 18, and 22 of the present application.

Instead, the Examiner states only that it would have been obvious to combine McDonald, Wang, Kuperstein, and TIFF “*to record the identification information loaded in the information loading step, in a header part of an image file in which the photographed subject image is recorded, motivation being the ability to sort and process digital images in a computer*” (see Office Action mailed November 29, 2005, at page 10, lines 10-14).

However, no citation to any of the cited references has been provided for such stated motivation. Thus, Appellants respectfully submit that the Examiner clearly has not provided any evidentiary basis for the motivation in the rejection of claims 8, 18, and 22 under 35 U.S.C. § 103(a).

Hence, the Examiner has clearly failed to establish a *prima facie* case of obviousness.


In view of the foregoing arguments, along with those arguments currently of record in the Response Under 37 C.F.R. § 1.116 filed on February 16, 2006, Appellants submit that the prior art rejections currently of record fail to meet the Examiner’s initial burden of a *prima facie* rejection, since the Examiner clearly has not provided any evidentiary basis for the motivation in the rejection of claims 8, 18, and 22 under 35 U.S.C. § 103(a) as being unpatentable over McDonald, Wang, Kuperstein, and TIFF.

Accordingly, Appellants respectfully submit that claims 1-41, all the claims presently pending in the application, are clearly patentable and are in condition for allowance.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee’s Deposit Account No. 50-0510.

Respectfully Submitted,

Date: May 1, 2006



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